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CHARLES ELWELL BENTLEY

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IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1944.

No. 472

GALLAND-HENNING MANUFACTURING COMPANY,
Petitioner,
vs.

LOGEMANN BROTHERS COMPANY,
Respondent.

**PETITION FOR WRIT OF CERTIORARI AND BRIEF
IN SUPPORT THEREOF.**

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PETITION FOR WRIT OF CERTIORARI.

*To the Honorable Chief Justice and Associate Justices of
the Supreme Court of the United States:*

Your petitioner, Galland-Henning Manufacturing Company, prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit, entered May 25, 1944 (R. 208), reported in 142 Fed. 2d 700. A petition for rehearing was denied June 23, 1944 (R. 209).

A certified transcript of the record, including the proceedings in the said Circuit Court of Appeals, is furnished herewith, in accordance with the rules of this Court.

NOTE: Italics ours unless otherwise stated.

Summary Statement of the Matter Involved.

Petitioner, Galland-Henning Manufacturing Company, through its bill of complaint filed March 5, 1942 (R. 1) in the District Court of the United States for the Eastern Division of Wisconsin, sought an injunction and an accounting of profits and damages for infringement of petitioner's patent No. 1,932,041, granted October 24, 1933 to petitioner as assignee of the inventor, Henry Jacobson for Baling Press (R. 104).

Respondent filed an answer on May 25, 1942 (R. 3) in which it denied that the patent was granted for an invention, and asserted that it is invalid, and also that it had not been infringed by respondent.

Petitioner took pre-trial depositions of the president and two employees of respondent, and at the trial in open court both parties examined expert witnesses and offered in evidence numerous exhibits.

During the trial, the Court and counsel viewed baling presses involved in the controversy (R. 46).

At the conclusion of the trial, oral arguments and printed briefs were presented by both parties.

On July 16, 1943, the District Court filed its opinion (R. 85), carefully reviewing the evidence, and comparing the prior art baling presses with the press of the patent in suit and with respondent's press, and holding "*I am of the opinion that Jacobson's development constitutes invention*" (R. 86), and that "*I am of the opinion that the claims in question are valid*" (R. 87), but holding that "defendant's accused press does not infringe the claims of the patent in suit" (R. 88).

On August 6, 1943, the District Court filed Findings of Fact (R. 88) and Conclusions of Law (R. 90). The Court found as facts that what Jacobson had done over the prior

art "required considerable redesigning" (R. 88), and that "*Jacobson's development constitutes invention*" (R. 89), but that "The claims of the patent in suit are not readable upon the structure of Defendant's accused press" (R. 90).

The Court's Conclusions of Law included "A. The patent in suit is valid", and "C. The Defendant's accused press does not infringe the claims of the patent in suit" (R. 90).

On August 6, 1943 a final decree was entered, dismissing the bill of complaint for want of equity (R. 91).

On August 26, 1943, petitioner filed its notice of appeal to the Court of Appeals for the Seventh Circuit. Briefs for both parties were filed, and the cause argued orally April 6, 1944, before the said Court of Appeals.

During the oral arguments, the Appellate Court suggested that petitioner file a special brief on the question "Whether the Finding of Invention Is One of Fact or Law". Petitioner promptly filed such a brief, and respondent filed a reply thereto.

On May 25, 1944, the Appellate Court filed its opinion (R. 200; 142 F. 2d 700), affirming the judgment but disagreeing with the District Court both as to infringement and invention, holding that respondent had infringed the patent in suit, but that while the Jacobson patent covered an invention, it was the result of mere mechanical skill.

A petition for rehearing was duly filed, and denied on June 23, 1944 (R. 209).

Jurisdiction.

This is a suit arising under the Patent Laws of the United States, 35 U. S. C. Sec. 70, and the Judicial Code, 28 U. S. C. Sec. 41(7).

The jurisdiction of this Court is invoked under Sec. 240(a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U. S. C. Sec. 347).

Questions Presented.

1. Is Rule 52(a), 3rd sentence, of Rules of Civil Procedure, limited to evidentiary facts, or does it include ultimate facts?

2. Is it within the intent and purpose of Rule 52(a) of the Rules of Civil Procedure that an appellate court should set aside a finding of fact by the District Court, which the appellate court has not held to be "clearly erroneous", and which is supported by evidence including the testimony of witnesses in open court?

3. Is a finding by a district court that a patentee has made an invention a "Finding of Fact" within the meaning of Rule 52(a) of the Rules of Civil Procedure?

4. May "invention" in patent law be the result of mere mechanical skill?

Reasons for Granting the Writ.

The discretionary powers of this Court to grant a writ of certiorari are invoked under Rule 38 of this Court, for the following reasons:

1. The Seventh Court of Appeals has held in effect that Rule 52(a), 3rd sentence, is limited to evidentiary facts and does not apply to findings of ultimate facts.

2. The judgment rendered by the Circuit Court of Appeals involves an interpretation and application of Rule 52(a) of the Rules of Civil Procedure in conflict with decisions of other circuit courts of appeals, in holding that a finding of fact that an "invention" has been made is a

finding of fact only that mere mechanical skill has been exercised.

3. The Circuit Court of Appeals has decided a Federal question in a way probably in conflict with applicable decisions of this Court in holding that a finding of fact of "invention" is not such a finding of fact as will not be set aside by an appellate court unless clearly erroneous.

4. The Circuit Court of Appeals has so far departed from the accepted and usual course of judicial proceedings under Rule 52(a) of the Rules of Civil Procedure as to call for an exercise of this Court's power of supervision, in that it has set aside a finding of fact supported by evidence, including the testimony of witnesses in open court, and which finding the appellate court has not held to be "clearly erroneous".

WHEREFORE, it is respectfully submitted that this petition for writ of certiorari to the Court of Appeals for the Seventh Circuit should be granted.

GEO. L. WILKINSON,
Counsel for Petitioner.

Chicago, Illinois,

September, 1944.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

The opinion of the District Court for the Eastern District of Wisconsin (R. 85), is reported in 51 Fed. Supp. 796.

The opinion of the Court of Appeals for the Seventh Circuit (R. 200) is reported in 142 F. 2d 700.

Specification of Errors.

The errors which petitioner will urge if the writ of certiorari is issued are that the Court of Appeals for the Seventh Circuit erred:

1. In setting aside a finding of fact of the District Court supported by evidence, including the testimony of witnesses in open court, which finding of fact was not held to be "clearly erroneous".

2. In disregarding the decisions of this Court that a finding of a district court as to invention is a finding of fact which, if supported by evidence, will not be disturbed by an appellate court.

3. In construing the terms "invented" and "invention" in the statute authorizing the granting of patents (35 U. S. C. A. Sec. 31; Sec. 4886 U. S. Rev. Stat.) so broadly as to include the result of mere mechanical skill, and in ignoring the fact that the term "invention" has for a hundred years been held by this Court to be the antithesis of mere mechanical skill.

Rule 52(a), Rules of Civil Procedure.

The District Court included in its Findings of Fact:

“2. Jacobson, Plaintiff’s assignor, added a transversely operating gathering ram to a standard two-compression press. *This required considerable re-designing*”, and

“3. The art relating to baling presses is quite highly developed and the claims of the patent in suit must be narrowly construed in view of the limitations imposed by the prior art. Thus construed, *Jacobson’s development constitutes invention.*” (R. 88 and 89), and in its Conclusions of Law:

“A. The Patent in Suit is valid.” (R. 90.)

The Court of Appeals has held that the Jacobson invention involved merely mechanical skill and is not a patentable invention, and consequently that the patent in suit is invalid. The construction and application of Rule 52(a) therefore is presented as the controlling question in this petition.

For convenient reference, the pertinent portion, *i. e.*, the third sentence, of Rule 52(a) is quoted as follows:

“Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.”

Reference to U. S. C. A. shows that the said rule, and particularly the third sentence thereof, has been considered and construed in probably more decisions than any other of the Federal rules of Civil Procedure, and that there has been a wide divergence of views concerning its purpose, intent and scope, particularly as to whether the term “Findings of Fact” includes ultimate facts or merely underlying or evidentiary facts.

The Advisory Committee on Rules of Civil Procedure in

its notes regarding the rules which it recommended and which were promulgated by this Court, said regarding Rule 52(a):

“The rule stated in the third sentence of Sub-division (a) accords with the decisions on the scope of the review in modern Federal equity practice. *It is applicable to all classes of findings in cases tried without a jury, whether the finding is of a fact concerning which there was conflict of testimony, or of a fact deduced or inferred from uncontradicted testimony.*”

Consistent with the statement of the Advisory Committee that the third sentence of said rule “accords with the decisions on the scope of the review in modern Federal equity practice”, are decisions of several circuit courts of appeal, as for instance the Court of Appeals for the Third Circuit in *Guilford v. Biggs*, 102 F. 2d 46, 47, from which the following statement is quoted:

“* * * The provisions of the new procedural rules that the findings of fact of the trial judge are to be accepted on appeal unless clearly wrong (Rule 52(a), 28 U. S. C. A. following section 723e) is but the formulation of a rule long recognized and applied by courts of equity. *Adamson v. Gilliland*, 242 U. S. 350, 37 S. Ct. 169, 61 L. Ed. 356; *Deutser v. Marlboro Shirt Co.*, 4 Cir., 81 F. 2d 139, 142; *Sherman v. Bramham*, 4 Cir., 78 F. 2d 443; *Miller v. Pyrites Co.*, 4 Cir., 71 F. 2d 804; *Suburban Imp. Co. v. Scott Lumber Co.*, 4 Cir., 67 F. 2d 335, 90 A. L. R. 330.”

To the same effect is the decision of the Court of Appeals for the Ninth Circuit in *Wittmayer v. United States*, 118 F. 2d 808, 811, from which the following quotation is made:

“The provisions of the new procedural rules that the findings of fact of the trial judge are to be accepted on appeal unless clearly wrong (Rule 52(a), 28 U. S. C. A. following section 723e), is but the formulation of a rule long recognized and applied by courts of equity. *Guilford Const. Co. v. Biggs*, 4 Cir., 102 F. 2d 46, 47.

“As was said by Mr. Justice Holmes in *Adamson v. Gilliland*, 242 U. S. 350, 353, 37 S. Ct. 169, 170, 61 L. Ed. 356 (citing *Davis v. Schwartz*, 155 U. S. 631, 636, 15 S. Ct. 237, 39 L. Ed. 289), the case is pre-eminently one for the application of the practical rule, that so far as the findings of the trial judge who saw the witnesses ‘depends upon conflicting testimony or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable.’ ”

In both of the above opinions the Circuit Courts of Appeal cited the decision of this Court in *Adamson v. Gilliland*, 242 U. S. 350, 353, in support of the statement that the rule under consideration is “but the formation of a rule long recognized and applied by courts of equity.”

The decision in *Adamson v. Gilliland* was in a patent case, and the finding of fact in question was “invention.” This Court said:

“* * * Considering that a patent has been granted to the plaintiff the case is preeminently one for the application of the practical rule that so far as the finding of the master or judge who saw the witnesses ‘depends upon conflicting testimony, or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable.’ *Davis v. Schwartz*, 155 U. S. 631, 636.”

As a further instance of the “modern Federal equity practice,” to accord with which the rule under consideration was promulgated, the decision of this Court in *United States v. United Shoe Machinery Co.*, 247 U. S. 32, 41, contains the following pertinent statement:

“* * * The testimony was conflicting, it is true, and different judgments might be formed upon it, but from an examination of the record we cannot pronounce that of the trial court to be wrong. Indeed, it seems to us to be supported by the better reason. We should

risk misunderstanding and error if we should attempt to pick out that which makes against it and disregard that which makes for it and judge of witnesses from their reported words as against their living presence, the advantage which the trial court had."

The decision of the Court of Appeals for the Eighth Circuit in *McGee v. Nee*, 113 F. 2d 543, 546, is in accord with the note of the Advisory Committee that the finding of fact may be "deduced or inferred from uncontradicted testimony," in that it held that the rule in question contemplated "ultimate" facts, as evinced by the following quotation:

"But if the court's findings of evidentiary facts were insufficient to support its findings of ultimate facts, that would present nothing for review, because the *findings of ultimate facts* in a jury-waived case, unless shown to be unsupported by evidence, or clearly erroneous in view of the evidence, *are conclusive on appeal*, and an appellate court cannot revise them but can only determine whether they support the judgment."

To the same effect is the following statement by the same Court in *Helvering v. Johnson*, 104 Fed. 2d 140, 144:

"Even in the light most favorable to the Government, this case appears to present a situation where, *the evidence being undisputed, fair-minded men may honestly draw different conclusions. In such a situation a reviewing court will not substitute its judgment for that of the fact finding body, but will accept the ultimate fact as found by it.*"

To the same effect is the decision of the 6th Circuit Court of Appeals in *Jergens Co. v. Conner*, 125 F. 2d 686, 689.

However, the Court of Appeals for the Third Circuit in *Kuhn v. Princess Lida*, 119 F. 2d 704, 706, takes an opposite view, namely, that ultimate facts are not within

the contemplation of Rule 52(a) as is evident from the following quotation:

"So long, therefore, as a finding of fact is supported by evidence and is not clearly erroneous, it is to be accepted on appeal as verity.

"The rule does not operate, however, to entrench with like finality the inferences or conclusions drawn by the trial court from its fact findings. And so, while accepting the facts competently found by the trial court as correct, an appellate court remains free to draw the ultimate inferences and conclusions which, in its opinion, the findings reasonably induce.

"The sufficiency of the evidence to sustain a trial court's conclusion or *finding of an ultimate fact remains appropriate matter for an appellate court's consideration.*"

The Seventh Circuit Court of Appeals in *Murray v. Noblesville*, 131 F. 2d 470, 474 cites with approval the above decision, and holds:

"To be sure, where the finding of fact is supported by evidence and is not clearly erroneous, it must be accepted by us, but the rule does not operate to entrench with like finality the inferences or conclusions drawn by the trial court from its fact findings and we are free to draw the ultimate inferences and conclusions which the findings reasonably induce, and where the evidentiary facts are not in conflict or dispute, the conclusions to be drawn therefrom are for the appellate court upon review."

In the instant case the Appellate Court has held that "there is no substantial controversy as to any evidentiary fact" (R. 207) and has set aside the finding of ultimate fact as to "invention" on the ground that it may be determined as a question of law.

There is, therefore, a clear conflict between the Circuit Courts of Appeal for the Sixth and Eighth Circuits, and the Circuit Courts of Appeal for the Third and Seventh

Circuits, as to whether Rule 52 (a) is limited to a finding of evidentiary facts or applies to a finding of ultimate facts.

“Unless Clearly Erroneous.”

It has been repeatedly emphasized by circuit courts of appeal that in order that an appellate court may be warranted in setting aside a finding of fact of a district court, it must be convinced that the district court's finding was clearly erroneous. That the appellate court might itself have found an ultimate fact differently from the trial court, or that a finding at variance with that of the trial court might have been reasonably found, does not, within the contemplation of the rule, authorize an appellate court to set aside a finding of fact as clearly erroneous.

The Court of Appeals for the Sixth Circuit in *Andrew Jergens Co. v. Conner*, 125 F. 2d 686, 689, held as follows:

“Appellants insist that the court's findings are not binding on appeal because they are legal conclusions or, at most, ultimate facts and that they are not supported by any substantial evidence. Where a case is tried by the court, a jury having been waived, the court's findings upon questions of fact are conclusive upon appeal, no matter how convincing the argument that upon the evidence the findings should have been different unless there is no substantial evidence to support them. We are bound by the lower court's findings unless they are clearly erroneous. Federal Rules of Civil Procedure, rule 52, 28 U. S. C. A. following section 723c.”

The Court of Appeals for the Eighth Circuit in *Bostian v. Levich*, 134 F. 2d 284, 287, said:

“While the trial court might well, no doubt, have reached a different conclusion, we have no right to declare that its findings here are clearly erroneous within the intendment of Federal Rules of Civil Procedure, rule 52(a), 28 U. S. C. A. following section 723c, and the judgment must accordingly be affirmed.”

To the same effect is the following statement of the same Court in *Rait v. Federal Land Bank*, 135 F. 2d 447, 451:

“ * * * Rule 52(a), Federal Rules of Civil Procedure, 28 U. S. C. A. following section 723e. On the record before us, we cannot declare the value fixed by the district judge to be clearly erroneous. *The fact that some other equally sustainable result might have been reached on the evidence is beside the point.*”

The same Court in *Storley v. Armour & Co.*, 107 F. 2d 499, 513, stated that:

“ * * * *It is not the function of this Court to retry this case * * * or to substitute its judgment for that of the trier of the facts which had reached permissible conclusions.*”

The Court of Appeals for the Second Circuit in *Corbett v. Halliwell*, 123 F. 2d 331, emphasized that Rule 52(a) only permits an appellate court to set aside findings of the trial court when convinced that they are clearly erroneous.

The “modern Federal equity practice,” with which the rule under consideration was intended to accord, is set forth as follows by this Court in *Gunning v. Cooley*, 281 U. S. 90, 94:

“ * * * Where uncertainty as to the existence of negligence arises from a conflict in the testimony or because, the *facts being undisputed, fair-minded men will honestly draw different conclusions from them*, the question is not one of law but of fact to be settled by the jury. *Richmond & Danville Railroad v. Powers*, 149 U. S. 43, 45.”

In view of the foregoing authorities, petitioner submits that the Court of Appeals for the Seventh Circuit disregarded the rule under consideration in setting aside the findings of fact of the District Court that “*Jacobson's development constitutes invention*” (R. 89), and “*that the*

claims in question are valid" (R. 87), which it did not hold were clearly erroneous, and holding that Jacobson had merely exercised mechanical skill (which, according to its opinion, might constitute "invention") but had not made a *patentable* invention.

A Finding as to Invention Is One of Fact.

That the finding of the District Court that "Jacobson's development constitutes invention" is one of fact, and therefore not to be set aside by the Appellate Court unless "clearly erroneous," is well-established by decisions of this Court and the lower Federal courts.

This Court in *St. Paul Plow Works v. Starling*, 140 U. S. 184, 196, stated that a finding of the lower court that the plaintiff's invention was anticipated, was a finding of fact which could not be reviewed. This Court said:

"We cannot review the finding of the Circuit Court that none of the earlier patents put in evidence by the defendant anticipated the plaintiff's invention. Although the defendant excepted to this finding as a conclusion of law, yet it was really a conclusion of fact on the evidence which the Circuit Court had before it."

This Court in speaking through Mr. Chief Justice Stone in *Concrete Appliances Co. v. Gomery*, 269 U. S. 177, 180, held regarding the question whether the plaintiff's appliance embodied invention:

"The question thus presented is one of fact."

This Court in *Thomson Spot Welder Co. v. Ford Motor Co.*, 265 U. S. 445, 446, held that:

" * * The question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention, is one of fact; and in an action at law for infringement is to be left to the determination of the jury."*

This Court in its comparatively recent decision in *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 367, expressly held that a finding of invention is a finding of fact which will not be disturbed. This Court said:

“* * * These findings are to the effect that the new combinations, while they involve old mechanical constructions, combine these in a new way so as to produce an improved result. *These are findings of fact*, despite the petitioner's apparent contention to the contrary, and we will not disturb such concurrent findings where, as here, there is evident to support them.”

Many of the Circuit Courts of Appeal have held in accordance with the decisions of this Court that a finding of invention is one of fact. In *Minnesota Mining & Mfg. Co. v. Coe*, 125 F. 2d 198, 199, the Circuit Court of Appeals said:

“* * * The court found as conclusions of law that the appealed claims were not inventive or patentable over the references. Strictly, *these are findings of fact*, and should be made as such, in accordance with Rule 52(a) of the Rules of Civil Procedure, 28 U. S. C. A. following section 723c.”

The Court of Appeals for the First Circuit in *B. F. Sturtevant Co. v. Massachusetts Hair & Felt Co.*, 122 F. 2d 900, 912, held:

“Since, as already appears, *this question of anticipation is one of fact*, and since upon a careful examination of the record we are unable to find that the master's conclusions with respect to all of these prior art patents are clearly erroneous, it follows that they must be affirmed.”

The Court of Appeals for the First Circuit in *National Development Co. v. Lawson-Porter Co.*, 129 F. 2d 255, 259, held as follows that a finding of inventive skill is one of fact:

“*The court below found ‘that the plaintiff's device*

was the result of the application of inventive skill', and we have no doubt that in this case that finding is one of fact. The plaintiff's machine, as indicated above, is a highly complex affair and the wording of the patent is such that the services of experts were required to explain it to and interpret it for the court below. Under these circumstances it is not for us to decide the question of patentable invention for ourselves, but to affirm the finding of the district court on that issue unless we are convinced that its finding thereon is clearly erroneous. Federal Rules of Civil Procedure, rule 52(a), 28 U. S. C. A. following section 723e."

The Court of Appeals for the Third Circuit in *Hazeltine Corp. v. General Motors*, 131 F. 2d 34, 37, reiterated the law that whether or not a patent shows invention is a question of fact, as follows:

"Whether a patent shows invention is a question of fact and the findings of the trier of fact upon this issue are not to be disturbed unless clearly erroneous or not supported by substantial evidence."

The Court of Appeals for the First Circuit in *Bellavance v. Frank Morrow Co.*, 141 F. 2d 378, in a very recent decision held that in view of the decision of this Court in *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U. S. 275, the question of invention is one of fact, and hence affirmed the decision of the District Court, on the question of invention as follows:

"In the Goodyear case there is a statement by three of the dissenting Justices, quoting Mahn v. Harwood, 112 U. S. 354, 358, decided in 1884, that the question of invention is not one of fact at all but one of law to be decided by the courts. This is not in accord with the categorical statement in the Thomson Spot Welder Company case, supra, decided in 1924, that 'The question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention, is one of fact; and in an action at law for infringement

is to be left to the determination of the jury.' See also *Hazeltine Corp. v. General Motors Corp.*, 131 F. 2d 34, 37 (55 U. S. P. Q. 158, 159-160), and cases cited. But, as I attempted to point out, I now think inadequately, in *Hanovia Chemical & Mfg. Co. v. David Buttrick Co.*, 127 F. 2d 888, 889, this statement of the minority is in accord with judicial behavior in a great many cases. However, since *a majority of the court in the Goodyear case obviously treated the question of invention as one of fact*, as we did in the case at bar, we see no reason here to do more than advert again to the confusion in the law with respect to the nature of the question of patentable invention."

In view of the foregoing authorities, petitioner submits that the finding of the District Court that "*Jacobson's development constitutes invention*" was clearly one of fact, and as the Circuit Court of Appeals did not hold such finding to be "clearly erroneous," it should not have refused, under the provisions of Rule 52(a), to accept such fact as found by the District Court.

May "Invention" in Patent Law Be the Result of Mere Mechanical Skill?

The Court of Appeals set aside the finding of fact of the trial court that "*Jacobson's development constitutes invention*," on the erroneous ground that "invention" does not connote patentability (R. 204), and that such finding therefore was not that Jacobson had made a patentable invention but only that he had exercised mere mechanical skill.

The Court of Appeals consequently set aside the finding of fact that "*Jacobson's development constitutes invention*" on the mistaken assumption that "frequently an invention is the result of mere mechanical skill" (R. 204).

U. S. Rev. Stat. Sec. 4886 (U. S. C. Title 35, Sec. 31) defines who may obtain a patent as follows:

“Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereon * * * not known or used by others in this country * * * may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.”

If the statutory term “invented” merely means that mechanical skill has been exercised, as stated by the Appellate Court, then the statute in authorizing the granting of a patent to “any person who has invented,” authorizes the granting of a patent to one who has exercised mere mechanical skill, provided the factors of novelty and utility are present.

The statute does not require that the novelty must be patentable, but does require that the applicant for a patent must have made an invention.

Presence or absence of invention is the factor which determines whether the novelty is patentable.

The holding of the appellate court that “frequently an invention is the result of mere mechanical skill” is in direct conflict with the recent decision of the Court of Appeals for the Sixth Circuit in *Westinghouse v. Powerlite*, 142 F. 2d 965, 966, in which it is stated:

“The Jennings conception had merit. Our problem, however, is to determine whether it *constituted invention* as that term, so incapable of definition, is applied in the patent law to denote contributions to a given art *beyond the routine skill of the mechanic*.”

The above decision of the Court of Appeals for the Sixth Circuit is in accord with, and the decision in the Court of Appeals for the Seventh Circuit in the instant case is

directly contrary to, decisions of this Court from *Hotchkiss v. Greenwood*, 11 How. 248 (1850) to *Detrola v. Hazeltine*, 313 U. S. 259, 260, (1940) in which latter decision this Court said:

“ * * * he was not in fact the first inventor, since his advance over the prior art, if any, required only the exercise of the skill of the art.”

That the District Court used the term “invention” in its finding of fact in accordance with its well-established definition as meaning a patentable invention, as distinguished from mere mechanical skill, conclusively appears from the conclusion that Jacobson’s patent is valid (R. 90). As the only attack made on the validity of the Jacobson patent was that it involved merely mechanical skill, the District Court necessarily used the term “invention” as meaning a patentable invention as distinguished from mere mechanical skill, as otherwise it could not have held that the Jacobson patent is valid.

That the Appellate Court erroneously construed the finding of the District Court that “Jacobson’s development constitutes invention” to be a finding that Jacobson had not made a patentable invention but had merely exercised mechanical skill, is further evident from the careful consideration of the defense of lack of invention, including the following statements in the opinion of the District Court (R. 86):

“ * * * It had been the previous experience in baling metal that fins were often formed on one or more sides of the bale, making it more difficult to pile, store, or otherwise handle.”

“This last compression is effected within three solid walls which does away with the possibility of metal fins, with the possible exception of one side.”

“* * * Thus construed, I am of the opinion that Jacobson's development constitutes invention.”

In view of the foregoing considerations, it is submitted that the District Court in finding that “*Jacobson's development constitutes invention*” (R. 59), found as a fact that Jacobson had not merely exercised mechanical skill but had made a patentable invention, which finding, as it is supported by evidence, should not have been set aside by the Appellate Court.

The decision of the Appellate Court in the instant case that “frequently an invention is the result of mere mechanical skill” (R. 204), is the law of this Circuit until corrected by this Court. The interests of the public and patent owners involved in litigation, of which there is a great deal in the Seventh Circuit, require, it is respectfully submitted by petitioner, that the erroneous decision of the Appellate Court should not be allowed to stand.

A finding of fact of a trial court based upon substantial evidence, that an “invention” has or has not been made by a patentee, should not be set aside, and Rule 52(a) evaded by an appellate court through the erroneous holding that “invention” may be mere mechanical skill.

Conclusion.

For the foregoing reasons, it is urged that this Petition for Writ of Certiorari be granted, and litigants in the Federal Courts advised by this Court as to the scope of Rule 52(a) of the Rules of Civil Procedure, and particularly whether the facts found by a district court, which “shall not be set aside unless clearly erroneous,” are

merely evidentiary facts or ultimate facts based upon evidentiary or underlying facts.

Respectfully submitted,

GALLAND-HENNING MANUFACTURING
COMPANY,

Petitioner,

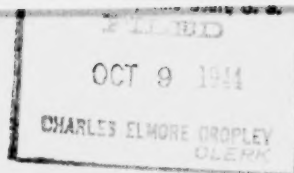
By GEO. L. WILKINSON,

Of Counsel.

Chicago, Illinois,

September, 1944.





IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1944.

No. 472

GALLAND-HENNING MANUFACTURING COMPANY,
Petitioner,

vs.

LOGEMANN BROTHERS COMPANY,
Respondent.

**RESPONDENT'S BRIEF IN OPPOSITION TO
PETITION FOR CERTIORARI.**

S. L. WHEELER,
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Milwaukee 3, Wis.,
Counsel for Respondent.







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DEFENDANT'S SUPPLEMENTAL STATEMENT.

The patent in suit has been adjudicated by only one District Court and one Circuit Court of Appeals (the Seventh Circuit), and they agreed in dismissing the Complaint.

The evidence is undisputed, the structure exceedingly simple, and the Appellate Court was in just as good a position as the District Court to pass on the validity of the patent.

The District Court found invention only as to a combination which it also found to be not embodied in Defendant's accused structure. The Court of Appeals gave the claims a different interpretation and held them void. The difference is primarily one of claim interpretation and, secondly, one of law as to the legal effect of undisputed facts applied to differently interpreted claims.

ARGUMENT.

The Petition is without merit for the following reasons:

I.

The District Court made no unqualified finding of invention. Its findings of invention and non-infringement are *interdependent and inseparable* as demonstrated by the following quotations from the findings (Tr. 88-90):

“Jacobson, Plaintiff’s assignor, added a transversely operating gathering ram to a standard two compression press.” (Finding 2.)

“To increase the width of the press box in which initial compression is effected, to enable such box to receive larger scrap, whereas in Defendant’s accused press there is no means for increasing the width of the press box.” (Finding 10.)

“Plaintiff’s patent strongly emphasizes in the specification as well as in the claims the manner and the order in which the compressions are effected.” (Finding 4.)

“Each of the claims in issue is a combination claim specifying a particular order of ram operation.” (Finding 5.)

“In Defendant’s accused device, the order of ram operation is not followed. In the accused press the order of ram operation is the same as that of the prior art Jacobson and Kruse 1,766,642. The rams are the same and their working faces are the same as those made by the Defendant under that patent.” (Finding 6.)

On the basis of these undisputed evidentiary facts, the District Court arrived at the following conclusions of fact:

“The art relating to baling presses is quite highly developed and the claims of the patent in suit must be narrowly construed in view of the limitations imposed

by the prior art. Thus construed, Jacobson's development constitutes invention." (Finding 3.)

"Defendant's accused press structure is manifestly excluded from the scope of the invention of the patent in suit as described in the specification and set forth in the claims thereof." (Finding 12.)

"The claims of the patent in suit are not readable upon the structure of Defendant's accused press." (Finding 13.)

Then as conclusions of law the District Court found the patent valid but not infringed by Defendant's non-equivalent structure.

The Court of Appeals ignored the finding that the claims are limited to include a gathering ram not found in Defendant's structure, but discussed the words "longitudinal" and "transverse" in the claims and treated these words as inept and not words of limitation, concluding their discussion of this phase in the following words:

"We think such subtle refinements cannot constitute a valid basis for the issuance of a patent or a defense against infringement." (Tr. 203.)

And in the last paragraph of the opinion, the Court said:

"There is no substantial controversy as to any evidentiary fact. We have before us models of the patent in suit, the alleged infringing device, and the former patent to Jacobson and Kruse which was declared invalid by this Court. This case may be determined by a mere comparison of these structures and extrinsic evidence is not needed for explanation, or evaluation of the prior art, or to resolve questions of the applications of descriptions to the subject matter. We are convinced that the disclosures do not disclose patentable invention. The District Court did not err in dismissing the bill of complaint for want of equity." (Tr. 207.)

It will be observed that the Appellate Court did not deny that the addition of a gathering ram to a two ram press

might have involved invention *at one stage of the art*, but held that:

“There are four ultimate facts which must exist before an invention is patentable,—authorship, ownership, novelty not as a result of mechanical skill, and utility. If they exist concurrently, the disclosure is patentable. If one is lacking, it is not patentable. This must be true, not because the finder of facts says so but because the statute says so.” (Tr. 205.)

In so deciding, the Court of Appeals for the Seventh Circuit is in complete harmony with the decision of this Court in *Milburn etc. v. Bavis-Bournonville*, 270 U. S. 390-402, from which we quote the next to the last sentence of the opinion:

“The fundamental rule, we repeat, is that the patentee must be the first inventor.”

In the case at bar, the patentee was not the first to introduce a gathering ram into a baling press. See Spencer patent of 1906 (Tr. 112). He merely aggregated such a ram with an ordinary two ram press to produce a three ram press differing from the Jacobson and Kruse press (Tr. 170), by substituting a gathering ram for the prior art high pressure ram at the other end of the box. See comparative exhibit diagrams (Tr. 72-78).

The fact that the District Court and the Appellate Court could so radically differ as to the meaning of the claims in suit shows that the claims in any event are void for indefiniteness. *General Electric Co. v. Wabash Corp.*, 304 U. S. 364, p. 369; *United Carbon Co., et al. v. Binney & Smith Co.*, 317 U. S. 228, p. 233.

II.

The first question or specification of error sought to be raised by the Petition, viz.—whether Rule 52a applies to ultimate facts as well as evidentiary facts, is entirely moot.

If the Court of Appeals erred in disregarding the evidentiary facts stated in Findings 4 to 11, inclusive, as made by the District Court and on which the Conclusion of non-infringement is based, that error was prejudicial to the Defendant,—not to the Petitioner,—for those Findings are based on ample, undisputed evidence of non-infringement of the claims as the District Court interpreted them.

Petitioner cannot play fast and loose with Rule 52a,—using it for its own benefit and disregarding it when considering findings favorable to Defendant.

III.

The second question or error assigned by the Petition is whether an Appellate Court can set aside a clearly erroneous Finding of Fact without expressly stating that it is clearly erroneous, or that there is no evidence to support it. This question is also moot, for the Appellate Court clearly stated its position in that portion of its Opinion appearing on page 204 of the Transcript from which we quote the following:

“The Plaintiff contends that if it appears from the findings of the court that the claims of a patent disclose an invention over the prior art, such findings of fact, if supported by evidence, will not be set aside by an appellate court. *With this contention we are in accord.*” (Italics ours.)

No other Circuit Court of Appeals ever went any further, or could have gone any further, in imparting inflexibility to Rule 52a as to findings of ultimate fact. Having

expressly recognized the rule, and having then found the patent invalid, the Court of Appeals has, in substance, ruled that on the evidence the finding of validity by the trial court was clearly erroneous.

Petitioner is not justified in quibbling over the form of words. It clearly appears that the court considered itself bound by Rule 52a, as stated in the above quotation from page 204 of the Transcript. The rule discussed on the last page of the Opinion is not Rule 52a but the rule that questions of invention, infringement, and validity may be regarded as questions of law when the evidentiary facts are undisputed.

This is the rule which the Court is discussing in the following quotation taken from page 207 of the Transcript, viz.:

“ ‘Where, with all the evidence before the court, it appears that no substantial dispute of fact is presented, and that the case may be determined by a mere comparison of structures and extrinsic evidence is not needed for purposes of explanation, or evaluation of prior art, or to resolve questions of the application of descriptions to subject-matter, the questions of invention and infringement may be determined as questions of law.’ This case may be determined by a mere comparison of these structures, and extrinsic evidence is not needed for explanation, or evaluation of prior art, or to resolve questions of the applications of descriptions to the subject matter. We are convinced that the disclosures do not disclose patentable invention. The District Court did not err in dismissing the bill of complaint for want of equity.” (Tr. 207.)

Where the evidence is undisputed, invention, lack of equivalence, and non-infringement are questions of law.

Smith v. Nichols, 88 U. S. 112, p. 118.

Mahn v. Harwood, 112 U. S. 354, p. 358.

Himmel Brothers Co. v. Serrick Corp., 122 F. (2d) 740, pp. 742-743.

IV.

The third and last assigned error is also moot. Certainly ever since the date of *Mahn v. Harwood*, 112 U. S. 354, Appellate Courts have not hesitated to reverse findings of invention where undisputed evidence or a mere inspection of the exhibits showed the structure claimed to be the result of mere mechanical skill.

The *Detrola* case, 313 U. S. 259, is one of the last utterances of the Supreme Court on this question, and in citing it, Petitioner overlooked the fact that it squarely supports the decision of the Circuit Court of Appeals in the case at bar.

The concluding paragraph of the Opinion of this Court in the *Detrola* case reads as follows:

“We conclude that Wheeler accomplished an old result by a combination of means which, singly or in similar combination, were disclosed by the prior art and that, notwithstanding the fact he was ignorant of the pending applications which antedated his claimed date of invention and eventuated into patents, he was not in fact the first inventor, since his advance over the prior art, if any, required only the exercise of the skill of the art.”

Detrola v. Hazeltine, 313 U. S. 259-269.

In the case at bar, the undisputed evidence shows that three ram presses were old (Tr. 170) and that Jacobson's three ram press merely involved adding a known gathering ram to a standard two ram press (Tr. 160) to produce a press of variable width, and that such gathering rams were old and disclosed in Figure 2 of a prior patent to Spencer (Tr. 114), (not a file wrapper reference). On the following pages, diagrams are reproduced of Defendant's Exhibits F-2 and F-3, in which the gathering ram of the patent in

suit (Defendant's Ex. F-2), is compared with that of the **Spencer patent** (Defendant's Ex. F-3), and shown to involve identical conceptions designed for the same purpose of widening a press box to receive bulky material. The Spencer patent is dated May 1, 1906. Therefore, there could be no dispute as to its priority. Spencer, and not Jacobson, did the designing necessary to provide a gathering ram, which then must be first operated to push the bulky material into the path of a longitudinally movable ram.

A mere inspection of these exhibits shows that the patent in suit is void as an aggregation of Spencer's gathering ram with a prior art two ram scrap metal baling press.

Conclusion.

For the foregoing reasons, it is urged that the Petition be denied, with costs.

Respectfully submitted,

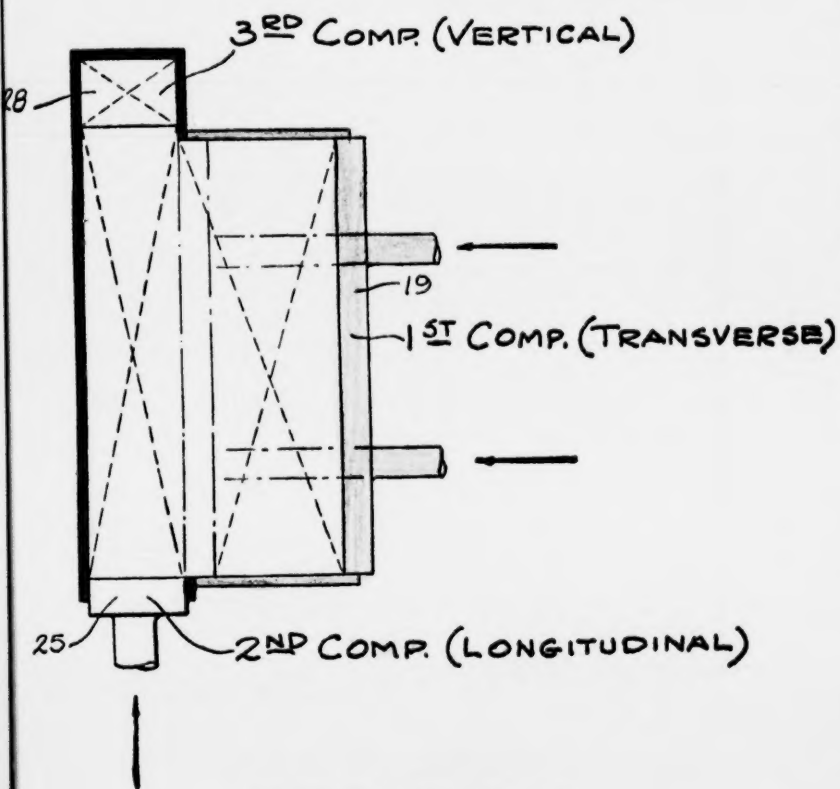
LOGEMANN BROTHERS COMPANY,
Defendant-Respondent,
 By S. L. WHEELER,
Of Counsel.

Proof of Service.

Received 3 copies of Respondent's Brief in Opposition to Petition for Writ of Certiorari this 5th day of October, 1944.

Counsel for Petitioner.

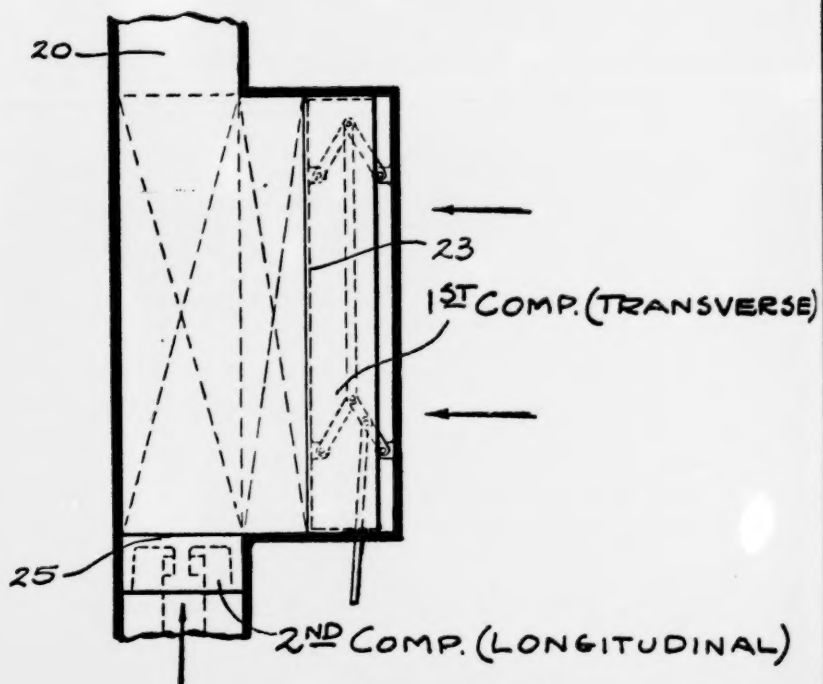
PLAN OF PRESS BOX OF PATENT IN SUIT



DEFENDANT'S EX. F 2

SPENCER PATENT 819,319 MAY 1, 1906

PLAN OF PRESS BOX



DEFENDANT'S EX. F 3

